2131 #9

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April 25, 2002

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Commissioner for Patents
Washington, DC 20231

Re: U.S. Utility Patent Application No. 09/986,319
Filed: November 8, 2001
Inventor: Timothy J. SIMMS
For: System and Method For Establishing Secure Communication Using A Shared Secret Key
Dkt. No.: 16222.004

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office are the following documents:

1. This Transmittal Letter;
2. An Information Disclosure Statement;
3. Form PTO-1449 (with 63 attached references); and
4. a Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

Sincerely,

Jay Chawla

Jay P. Chawla (Reg. No. 44,073)
Leslie L. Jacobs, Jr. (Reg. No. 40,659)

Enclosures

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#9

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APR 29 2002
Technology Center 2100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of SIMMS, *et al.*

Appln. No. 09/986,319 Group Art Unit: 2131

Filed: November 8, 2001 Examiner: To Be Assigned

For: **SYSTEM AND METHOD FOR ESTABLISHING SECURE COMMUNICATION USING A SHARED SECRET KEY**

Atty. Dkt.: 16222.004

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Please find enclosed copies of the documents listed on the attached Form PTO – 1449, which are submitted for the Examiner's review.

CONCISE STATEMENT OF RELEVANCE

It is respectfully requested that the information above be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

Included among the references in this IDS is a European patent, and its corresponding PCT application, each published in the French language. Applicant provides the following concise statements of relevance for both of these related references.

Patent EP 0 824 732 B1 contains a French specification, and claim sets in English, German, and French. In addition to inviting the Examiner to consider the aforementioned English claims, Applicant provides the English language claim set as a concise statement of the relevance of Patent EP 0 824 732 B1:

> "*1. Tamper protection and activation method for an electronic gaming device including at least one housing (BT), as well as at least one portable article (OB) capable of cooperating with the housing, in which method at least one result-encryption key is stored in the housing and an authenticatable set of digital game data (JE) representative of a game is stored in the portable article, the*

portable article is made to cooperate with the housing, the authentication of the set of game data is verified (8) within the housing and this set of game data is stored in a working memory (MT) of the housing, in such a way as to authorize the running (9) of the game in the housing, then, after the running of at least a part of the game, a result information item (IFR) dependent on the said game is encrypted (10) within the housing with the aid at least of the said result-encryption key, and this encrypted result information item (IFRc) is stored (11) in a result memory (MR) of the portable article, then, the portable article is made to cooperate with a validation station (ST) having access to the said result-encryption key, the said station performing a validation processing (13) on the basis at least of the said encrypted result information item and of the said result-encryption key.

2. *Method according to Claim 1, characterized in that the validation process includes decryption of the encrypted result information items.*

3. *Method according to Claim 1, characterized in that the unencrypted result information item is stored in the portable article, jointly with encrypted result information item, and in that the validation processing includes re-encryption of the unencrypted result information item stored in the portable article and a comparison of this re-encrypted result information item with the encrypted result information item stored in the result memory of the portable article.*

4. *Method according to one of Claims 1 to 3, characterized in that when the authentication of the set of game data of the portable article has been verified and the said set has been stored in the working memory of the housing, all subsequent utilization, by the housing, of the set of game data of this portable article is prohibited (20).*

5. *Method according to Claim 4, characterized in that, the device comprising several housings and several portable articles, when the authentication of the set of game data of one of the portable articles has been verified and when the said set has been stored in the working memory of one of the housings, all subsequent utilization, by any one of the housings, of the set of game data of this portable article is prohibited.*

6. *Method according to one of the preceding claims, characterized in that the set of game data stored in the portable article is authenticated by appending thereto an authentication certificate (CTF) linked in a one-to-one manner with the said set of game*

data (JE) and in that the verification of the authentication of the set of game data includes a recalculation of the authentication certificate within the housing and a comparison between the recalculated authentication certificate and the authentication certificate stored in the portable article.

7. *Method according to Claim 4 or 5 taken in combination with Claim 6, characterized in that all subsequent utilization of a set of game data is prohibited by altering, in the corresponding portable article, at least partially the said authentication certificate and/or at least partially the set of game data.*

8. *Method according to one of the preceding claims taken in combination with Claim 4, characterized in that the storage of the encrypted result information item in the portable article is authorized (21) only if all subsequent utilization of the set of game data of this portable article has been previously prohibited.*

9. *Method according to one of the preceding claims, characterized in that a housing-encryption key (Kf) is stored in the housing.*

10. *Method according to one of the preceding claims, characterized in that at least one game-encryption key (Km) is stored in the housing, in that the authentication of the set of game data stored in the portable article includes at least partial encryption of this set of game data, or of an information item (CTF) linked with this set of game data, with the aid of the game-encryption key (Km), before reading by the housing, and in that the verification of the authentication of this set of game data includes decryption within the housing with the aid of the game-encryption key.*

11. *Method according to Claims 6 and 10, characterized in that only the authentication certificate (CTF) is encrypted and decrypted.*

12. *Method according to Claim 9 taken in combination with Claim 10 or 11, characterized in that the game-encryption key (Km) having been encrypted with the aid of the housing-encryption key (Kf) is stored in the housing.*

13. *Method according to Claim 9 taken in combination with one of Claims 10 to 12, characterized in that, the device including several housings and several portable articles, a different housing-encryption key (Kf) is associated with each housing whilst the game-encryption key (Km) is common for all the housings and to all the portable articles, in that the housing-encryption key of a housing is stored in the latter before storage of the game-encryption key, and in that the set of game data of a portable* *article is stored in the latter, already at least partially encrypted, or associated with an information item (CTFc) already at least partially encrypted, with the aid of the game-encryption key.*

14. *Method according to Claim 9 or one of Claims 10 to 13, characterized in that the result-encryption key (Kr) is the housing-encryption key (Kf), or the game-encryption key (Km), or is obtained from a combination of the housing-encryption key and of the game-encryption key.*

15. *Method according to one of the preceding claims, characterized in that a key information item (ICR) associated in a one-to-one manner with the said result-encryption key is stored in the portable article cooperating with the housing, and in that the validation station has access to the said result-encryption key by reading the said key information item stored in the portable article.*

16. *Method according to one of the preceding claims, characterized in that the set of game data (JE) of a portable article is read by way of a serial protocol between the portable article and the housing.*

17. *Electronic gaming device, characterized in that it comprises at least one housing (BT), at least one portable article (OB), and at least one validation station (ST), in that the portable article includes a game memory (MJ) containing an authenticatable set of game data (JE) representing a game, a result memory (MR) able to contain an encrypted result information item (IFRc), a first communication interface (ESC) able to [cooperate with a housing-communication interface (ESB), and a second communication interface (ESC) able to] communicate with a station-communication interface (ESS), in that the housing includes a key memory (MC) containing a result-encryption key, a write- and read-accessible working memory (MT), and a processing unit (UT) linked to these memories as well as to the housing-communication interface, the processing unit being capable, during cooperation between the housing-communication interface [and the first communication interface of the article, of verifying the authentication of the set of game data stored in the article and of storing the said set in the working memory so as to allow the running of the game in the housing, then of encrypting a result information item (IFR) dependent on the said game, with the aid of the result-encryption key, and of communicating this encrypted result information item (IFRc) to the housing-communication interface for the purposes of the storage thereof in the result memory of the article, and in that the validation station (ST) includes means (PR) able to determine the said result-encryption key and station-processing means (PR) able*

to read the encrypted result information item via the station-communication interface, during cooperation between the portable article and the station, and to perform a validation processing from at least this encrypted result information item and the result-encryption key.

18. *Device according to Claim 17, characterized in that the station-processing means include station-decryption means able to decrypt the encrypted result information item.*

19. *Device according to Claim 17, characterized in that the processing unit of the housing is able also to communicate the unencrypted result information item to the housing-communication interface for the purposes of storage thereof in the result memory of the article, and in that the station-processing means are furthermore able to read the unencrypted result information item via the station-communication interface, and include station-encryption means able to encrypt the said unencrypted result information item with the aid of the result-encryption key, as well as comparison means for comparing the recalculated encrypted result information item with the encrypted result information item stored in the result memory of the portable article.*

20. *Device according to one of Claims 17 to 19, characterized in that the first communication interface (SEC) of the portable article is a serial interface.*

21. *Device according to one of Claims 17 to 20, characterized in that the authenticatable set of game data is associated with an authentication certificate and in that the means of verifying the authentication of this set of game data include certificate calculation means able to recalculate the said authentication certificate from the set of game data, and comparison means able to compare the recalculated certificate and the certificate stored in the game memory of the portable article.*

22. *Device according to one of Claims 17 to 21, characterized in that it comprises encryption means able to encrypt at least partially the set of authenticatable game data (JE), or an information item (CTF) linked with this set of game data, from at least one game-encryption key, and in that the key memory of the housing is able to contain the said game-encryption key whilst the means of verifying the authentication of the set of game data include decryption means linked to the key memory.*

> *23.* *Device according to Claims 21 and 22, characterized in that the encryption means encrypt only the authentication certificate (CTF).*
>
> *24.* *Device according to Claim 22 or 23, characterized in that the encryption means (CPU) are incorporated with the portable article.*
>
> *25.* *Device according to one of Claims 22 to 24, characterized in that the game-encryption key is stored encrypted and in that the processing unit (UT) of the housing includes means for decrypting this game-encryption key.*
>
> *26.* *Device according to one of Claims 17 to 25, characterized in that it comprises means (CPU) for invalidating the authenticatable set of game data of a portable article.*
>
> *27.* *Device according to one of Claims 17 to 26, characterized in that it comprises means (CPU) for prohibiting the writing of the encrypted result information item to the result memory of the portable article.*
>
> *28.* *Device according to Claim 26 or 27, characterized in that the invalidation means (CPU) and/or the prohibiting means (CPU) are incorporated into the portable article.*
>
> *29.* *Device according to one of Claims 17 to 28, characterized in that it comprises several housings, several portable articles and several validation stations, any one of the portable articles being capable of cooperating with any one of the housings and with any one of the validation stations."*

WO 96/34368 is a French language PCT application corresponding to Patent EP 0 824 732 B1. It contains an English language abstract, which Applicant provides as a concise statement of relevance of PCT application WO 96/34368:

> *"An electronic gaming device has one or more housing with at least one result-encryption key stored therein, as well as a portable article adapted for cooperating with the housing and with a set of authenticatable digital game data representative of a game stored therein. The portable article is made to co-operate with the housing. The set of game data is authenticated in the housing and stored in a working memory of the housing so as to authorize the progression of the game in the housing. After completion of at least part of the game, result information dependent on said game is encrypted in the housing by means of at least one result-encryption key, and the encrypted result information is stored in a result memory of the portable article, which then co-operated with a validation*

station capable of accessing the result-encryption key, whereafter said station verifies the result information."

CERTIFICATION AND/OR FEE

Because this Information Disclosure Statement is being submitted prior to issuance of the first action on the merits of the above-captioned application, no certification or fee is required.

If any charges are deemed appropriate, applicants hereby authorize the U.S. Patent Office to charge any fee to our Deposit Account No. 50-1824 under our reference number 16222.004

Respectfully submitted,

Jay Chawla

Leslie L. Jacobs, Jr. (Reg. No. 40,659)
Jay P. Chawla (Reg. No. 44,073)

Date: 4/25/02

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FORM PTO-1449
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO. 16222.004		APPLICATION NO.: 09/986,319
APPLICANT Timothy J. SIMMS		
FILING DATE November 8, 2001		GROUP 2651

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	4,200,770	04/29/1980	Hellman et al	H04L 9	04	09/06/1977
	AB1	5,241,599	08/31/1993	Bellovin et al	H04L 9	00	10/02/1991
	AC1	5,172,414	12/15/1992	Reeds, III et al	H04L 9	02	09/13/1991
	AD1	5,440,635	08/08/1995	Bellovin et al	H04K 1	00	08/23/1993
	AE1	5,418,854	05/23/1995	Kaufman et al	H04K 1	00	04/28/1992
	AF1	5,497,421	03/05/1996	Kaufman et al	H04K 1	00	09/28/1994
	AG1	5,535,276	07/09/1996	Ganesan	H04K 1	00	07/09/1996
	AH1	5,539,826	07/23/1996	Dwork et al	H04L 9	32	12/29/1993
	AI1	5,701,434	12/23/1997	Takashima et al	H04L 9	00	11/29/1995
	AJ1	5,732,137	03/24/1998	Aziz	H04L 9	00	01/03/1997
	AK1	5,748,736	05/05/1998	Mittra	H04K 1	00	06/14/1996

FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	EP 0 292 790 A2	11/30/1998	Europe	HO4L 9	00	☐ Yes ☐ No
	AM1	EP 0 292 790 A3	11/30/1988	Europe	HO4L 9	00	☐ Yes ☐ No
	AN1	EP 0 292 790 B1	11/30/1988	Europe	H04L 9	00	☐ Yes ☐ No
	AO1	EP 0 532 226 A2	03/17/1993	Europe	H04L 9	08	☐ Yes ☐ No
	AP1	EP 0 532 226 A3	03/17/1993	Europe	H04L 9	08	☐ Yes ☐ No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
	AS	2	Palmegren, Keith, "Diffie-Hellman Key Exchange: A Non-mathematician's Explanation" http://securityportal.com/topnews/dhkeyexchange20000706.html, (printed on 08/02/2001)

EXAMINER	DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

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	APPLICANT Timothy J. SIMMS	
	FILING DATE November 9, 2001	GROUP 2651

U.S. PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	5,778,065	07/07/1998	Hauser et al	H04L 9	00	02/08/1996
	AB2	5,604,803	02/18/1997	Aziz	H04L 9	00	06/03/1994
	AC2	5,790,548	08/04/1998	Sistanizadeh et al	H04L 12	66	04/18/1996
	AD2	5,870,474	02/09/1999	Wasilewski et al	H04L 9	00	12/29/1995
	AE2	5,872,847	02/16/1999	Boyle et al	H04K 1	00	07/30/1996
	AF2	5,953,424	09/14/1999	Vogelsang et al	H04L 9	32	03/18/1997
	AG2	5,978,478	11/02/1999	Korematsu	H04K 1	02	07/09/1997
	AH2	6,032,260	02/29/2000	Sasmazel et al	G06F 11	00	11/13/1997
	AI2	6,038,322	03/14/2000	Harkins	J04L 9	08	10/20/1998
	AJ2	6,044,468	03/28/2000	Osmond	H04L 9	00	08/25/1997
	AK2	6,058,476	05/02/2000	Matsuzaki et al	H04L 9	00	05/21/1997

FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL2	EP 0 532 226 B1	03/17/1993	Europe	H04L 9	08	☐ Yes ☐ No
	AM2	EP 0 661 845 A2	07/05/1995	Europe	H04L 9	32	☐ Yes ☐ No
	AN2	EP 0 661 845 A3	07/05/1995	Europe	H04L 9	32	☐ Yes ☐ No
	AO2	EP 0 686 905 A1	12/13/1995	Europe	G06F 1	00	☐ Yes ☐ No
	AP2	EP 0 808 535 B1	12/15/1999	Europe	H04L 9	32	☐ Yes ☐ No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
	AR	2	Connolly, P.J., "Peer to peer network security may depend soon on the strength of your 'reputation'" http://www.inforworld.com/articles/op/xml/1/03/19/010319opswatch.xml, (printed 08/02/2001)
	AS	3	Gomes, Lee, WSJ Interactive Edition: "Is P2P plunging off the deep end?", http://www.zdnet.com/zdnn/stories/news/0,4586,2704598,00.html, (printed 08/02/2001)

EXAMINER	DATE CONSIDERED

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FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	APPLICANT Timothy J. SIMMS	
	FILING DATE: November 9, 2001	GROUP ART UNIT: 2651

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AA	3	Bernhart, Andy, "*Share and Share Alike: Will P2P technology transform the B2B world?*", http://www.sdmagazine.com/articles/2001/0102/0102e/0102e.html, (printed on 08/02/2001)
	AB	3	http://www.arabia.com/jordan/article/0,5127,Business%7C11232%7C18-03-2001,00.html, (printed on 08/02/2001)
	AC	3	Gutberlet, Lisa, "*Peer – to – Peer Computing – A Technology Fad or Fact*", http://www.ebs.de/Lehrstuehle/Wirtschaftsinformatik/Lehre/Seminar00/p_gutberlet.pdf, (printed on 08/02/2001)
	AD	3	"Chapter 9 – Ensuring Messaging Security" http://www.microsoft.com/technet/treeview/default.asp?url=/TechNet/prodtechnol/exchange/proddocs/ex2kupgr/planus/p_09_ttl.asp, (printed on 08/02/2001)
	AF	3	Kaufman et al. "Network Security: PRIVATE Communication In A Public World" Prentice Hall. Chapter 5 pgs. 131 – 162 (1995)
	AG	3	Kaufman et al. "Network Security: PRIVATE Communication In A Public World" Prentice Hall. Chapter 9 pgs. 223 – 264 (1995)
	AH	3	Kaufman et al. "Network Security: PRIVATE Communication In A Public World" Prentice Hall. Chapter 10 pgs. 265 – 294 (1995)
	AI	3	Bace. "Technology Series: Intrusion Detection". MacMillan Technical Publishing. Chapter 6 pgs 135 – 154 (2000)
	AJ		
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	AQ	3	
	AR	3	
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ATTY. DOCKET NO. **16222.004**

APPLICATION NO.: **09/986,319**

APPLICANT **Timothy J. SIMMS**

FILING DATE **November 8, 2001**

GROUP **2651**

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	6,075,861	06/13/2000	Miller, II	H04L 9	32	05/29/1996
	AB1	6,085,320	07/04/2000	Kaliski, Jr.	H04L 9	00	04/21/1997
	AC1	6,097,817	08/01/2000	Bigic et al	H04K 1	10	12/10/1997
	AD1	6,101,182	08/08/2000	Sistanizadeh et al	H04L 12	66	11/25/1997
	AE1	6,119,227	09/12/2000	Mao	H04L 9	00	03/17/1996
	AF1	6,151,676	11/21/2000	Cuccia et al	H04L 9	00	12/24/1997
	AG1	6,189,096	02/13/2001	Haverty	H04L 9	32	08/06/1998
	AH1	6,189,098	02/13/2001	Kaliski, Jr.	H04L 9	00	03/16/2000
	AI1						
	AJ1						
	AK1						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	EP 0 824 732 B1	06/23/1999	Europe	G07C 15	00	☐ Yes ☐ No
	AM1	WO 96/24997	08/15/1996	WIPO	H04L 9	32	☐ Yes ☐ No
	AN1	WO 96/34368	10/31/1996	WIPO	G07C 15	00	☐ Yes ☐ No
	AO1	WO 98/26538	06/18/1998	WIPO	H04L 9	32	☐ Yes ☐ No
	AP1	WO 99/34554	07/08/1999	WIPO	H04L 9	30	☐ Yes ☐ No

EXAMINER INITIALS	REF. NO.	OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
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	AA1						
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	AI1						
	AJ1						
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	EP 1 041 823 A2	10/04/2000	Europe	H04N 7	167	☐ Yes ☐ No
	AM1	WO 00/32475	06/08/2000	WIPO	B65B 3	32	☐ Yes ☐ No
	AN1	WO 00/72503 A1	11/30/2000	WIPO	H04L 9	30	☐ Yes ☐ No
	AO1	WO 01/11817 A2	02/15/2001	WIPO	H04L 9	00	☐ Yes ☐ No
	AP1	WO 01/11817 A3	02/15/2001	WIPO	H04L 29	06	☐ Yes ☐ No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
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Page 6 f 6

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APPLICATION NO.: **09/986,319**

APPLICANT **Timothy J. SIMMS**

FILING DATE **November 8, 2001**

GROUP **2651**

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	GRANT DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1						
	AB1						
	AC1						
	AD1						
	AE1						
	AF1						
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	AH1						
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	AJ1						
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIALS	REF. NO.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	WO 01/13201 A2	02/22/2001	WIPO	G06F 1	00	☐ Yes ☐ No
	AM1	WO 01/13201 A3	02/22/2001	WIPO	H04L 29	06	☐ Yes ☐ No
	AN1						☐ Yes ☐ No
	AO1						☐ Yes ☐ No
	AP1						☐ Yes ☐ No

EXAMINER INITIALS	REF. NO.		OTHER (Including Author, Title, Date, Pertinent Pages, etc.)
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